

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s) : CHOY and CHANG
U.S. Serial No. : 09/555,544
For : MATERIAL DEPOSITION
Filed : August 1, 2000
Examiner : John M. Hoffman
Group Art Unit : 1731

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ON SEPTEMBER 23, 2007**

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF AND REQUEST
FOR EXTENSION OF TIME**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTION

This is an Appeal from the December 27, 2005 Final Rejection by the Examiner, finally rejecting claims 29-56 and the Notice of Non-Compliant Appeal Brief dated March 23, 2007. The Notice of Non-Compliant Appeal Brief was mailed by the Patent and Trademark Office on March 23, 2007, setting the deadline for filing a revised Appeal Brief as April 23, 2007. Pursuant to 37 C.F.R. §§1.136(a) and 1.17(a), it is respectfully requested that the period for filing the Appeal Brief be extended five months, i.e., up to and including September 23, 2007.

The Commissioner is hereby authorized to charge the requisite fee set forth in 37 C.F.R. §1.17(c) of \$250.00 for a small entity; along with the requisite fee of \$1080.00 for the extension

of time, as well as any additionally required fee for this Brief, or occasioned by this paper, or credit any overpayment in such a fee, to Deposit Account No. 50-0320.

RELIEF REQUESTED

It is respectfully requested that the rejection of claims 29-56 be reconsidered and withdrawn, and that a Notice of Allowance promptly issue.

REAL PARTY IN INTEREST

The real party in interest is Innovative Materials Processing Technologies Limited, having an address of: 90 Fetter Lane, London, Great Britain, EC4A 1JP.

RELATED APPEALS AND INTERFERENCES

Upon information and belief, the undersigned attorney does not believe that there is any appeal or interference that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

Claims 45-50 and 52-56 as set forth in Appendix A hereto (Exhibit A), are rejected under 35 U.S.C. §102(b) as being anticipated by Hitachi (JP 56-5337).

Claim 51 as set forth in Appendix A hereto (Exhibit A), is rejected under 35 U.S.C. §103(a) as unpatentable over Hitachi (JP 56-5337) in view of Japan 62-220376.

Claims 29-50 and 52-56 as set forth in Appendix A hereto (Exhibit A), are rejected under 35 U.S.C. §103(a) as unpatentable over Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (U.S. Patent 6,312,656).

Claims 29-44 as set forth in Appendix A hereto (Exhibit A), are rejected under 35 U.S.C. §103(a) as unpatentable over Choy *et al.* (WO 97/21848) in view of Hitachi (JP 56-5337).

Claim 51 as set forth in Appendix A hereto (Exhibit A), is rejected under 35 U.S.C. §103(a) as unpatentable over Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (U.S. Patent 6,312,656) and further in view of Japan 62-220376.

Currently pending claims under appeal include claims 29-56. Claims 1-28 have been previously cancelled.

STATUS OF THE AMENDMENTS

Appellants believe that all the Amendments and papers submitted prior hereto have been entered.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention involves a method of depositing material on a substrate, comprising the steps of: delivering from a first outlet a stream of droplets of a precursor liquid towards a substrate (see page 1, lines 29-30) applying an electric field between the first outlet and the substrate (see page 1, lines 30-31); and delivering from a second outlet a flow of fuel (see page 2, lines 26-27) about the stream of droplets such as to provide an annular flame combustion region between the first outlet and the substrate through which at least a portion of the stream of droplets passes before reaching the substrate, whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, to provide the deposited material, as set forth in claim 29, one of three independent claims and upon which claims 30-44 depend either directly or indirectly (page 3, lines 9-20).

The present invention also involves an apparatus for depositing material on a substrate as depicted in Figure 1, comprising: a nozzle assembly (10) including a first outlet (60) from which a stream of droplets of a precursor liquid is in use delivered to a substrate (50) (see page 2, lines 5-7), and a second outlet (40) from which a flow of fuel is in use delivered (see page 2, lines 26-27) such as to provide an annular flame combustion region (70) (see page 3, lines 9-11) through which at least a portion of the stream of droplets in use passes before reaching the substrate (50) (see page 2, lines 10-11); a precursor supply for supplying a precursor liquid to the nozzle assembly (see page 2, lines 7-8); an electrical supply (45) for applying an electric field between the first outlet and the substrate (see page 2, lines 8-9); and a burner for generating the flame of the annular flame combustion region between the first outlet and the substrate (see page 2, lines 9-10); whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, in the annular flame combustion region to provide the deposited material, as set forth in claim 45, the second of three independent claims, and upon which claims 46-50 and 52-56 depend either directly or indirectly. (see page 3, lines 9-20).

The present invention additionally involves an apparatus for depositing material on a substrate, comprising a nozzle assembly including a first outlet from which a stream of droplets of a precursor liquid is in use delivered to a substrate, and a second outlet from which a flow of fuel is in use delivered such as to provide an annular flame combustion region through which at least a portion of the stream of droplets in use passes before reaching the substrate; a mesh (as shown as 90 in Figure 1) disposed between the first outlet and the substrate (see page 3, lines 24-

25); a precursor supply for supplying a precursor liquid to the nozzle assembly (see page 2, lines 7-8); an electrical supply for applying an electric field between the first outlet and the substrate (see page 2, lines 8-9); and a burner for generating the flame of the annular flame combustion region between the first outlet and the substrate (see page 2, lines 9-10); whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, in the annular flame combustion region to provide the deposited material, as set forth in claim 51, the third of three independent claims. (see page 3, lines 10-20, 24-25).

All of claims 29-56 require the presence of an annular flame combustion region between the first outlet and the substrate.

The embodiments of the claims of the present application are patentable over (i) Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (US 6,312,656), (ii) Hitachi (JP 56-5337), (iii) Hitachi (JP 56-5337) in view of Japan 62-220376, (iv) Choy *et al.* (WO 97/21848) in view of Hitachi (JP 56-5337), and (v) Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (U.S. Patent 6,312,656) and further in view of Japan 62-220376.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A) Claims 45-50 and 52-56 Are Patentable Over Hitachi (JP 56-5337)

Whether claims 45-50 and 52-56 that are clearly patentable over Hitachi (JP 56-5337), should be allowed as there is no teaching or suggestion of the claimed methods and apparatus including an annular flame combustion region especially when:

- Hitachi is directed to an apparatus whereby a gas entraining a spray of a liquid (1) is ignited and combusted at the mouth of the nozzle (11') through which the gas is delivered, wherein the nozzle (11') is an open, tubular section, such that the resulting flame manifestly cannot be annular; and,
- Therefore, Hitachi fails to teach each and every one of the elements of claims 45-50 and 52-56, and particularly fails to teach an annular flame.

B) Claim 51 Is Patentable Over Hitachi (JP 56-5337)

Whether claim 51 that is clearly patentable over Hitachi (JP 56-5337) in view of Japan 62-220376, should be allowed as there is no teaching or suggestion of the claimed methods and apparatus including an annular flame combustion region especially when:

- Hitachi is directed to an apparatus whereby a gas entraining a spray of a liquid (1) is ignited and combusted at the mouth of the nozzle (11') through which the gas is delivered, wherein the nozzle (11') is an open, tubular section, such that the resulting flame manifestly cannot be annular; and,
- Japan 62-220376 is directed to an apparatus having a mesh electrode which serves to create a corona discharge between two electrodes, and is wholly different from the mesh of the present claims which removes soot from the flame, and in any event, does not provide any teaching of an annular flame; and,
- there is no teaching, suggestion or motivation in the art to modify Hitachi, and Japan 62-220376 to arrive at the recitations of claim 51.

C) Claims 29-50 and 52-56 Are Patentable Over Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (US 6,312,656)

Whether claims 29-50 and 52-56 that are clearly patentable over Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (US 6,312,656), should be allowed as there is no teaching or suggestion of the claimed methods and apparatus including an annular flame combustion region especially when:

- Choy *et al.* is directed to an apparatus and method which requires an increasing temperature gradient between the outlet (5) and the substrate (14), as disclosed in the summary of the invention at page 1, lines 22 to 30, particularly lines 29 and 30;
- Blackwell *et al.* is directed to a combustion region; and,
- Blackwell *et al.* discloses the delivery of fuel through an annular outlet, this being the outlet defined by the outermost channel (47); the outermost channel (47) being a frusto-conical channel and not a cylindrical channel; wherein the channels (43-47) are concentric (column 9, lines 6 and 7), meaning that the channels (43-47) have a common center; and wherein the outermost channel (47), in being a frusto-conical channel, manifestly cannot provide for the generation of an annular flame combustion region; and,
- there is no teaching, suggestion or motivation in the art to modify Choy *et al.* and Blackwell *et al.* to arrive at the recitations of dependent claims 30-44 and 46-56.

D) Claims 29-44 Are Patentable Over Choy et al. (WO 97/21848)
in view of Hitachi (JP 56-5337)

Whether claims 29-44 that are clearly patentable over Choy *et al.* (WO 97/21848) in view of Hitachi (JP 56-5337), should be allowed as there is no teaching or suggestion of the claimed methods and apparatus including an annular flame combustion region especially when:

- Choy *et al.* is directed to an apparatus and method which requires an increasing temperature gradient between the outlet (5) and the substrate (14), as disclosed in the summary of the invention at page 1, lines 22 to 30, particularly lines 29 and 30; and,
- Hitachi is directed to an apparatus whereby a gas entraining a spray of a liquid (1) is ignited and combusted at the mouth of the nozzle (11') through which the gas is delivered, wherein the nozzle (11') is an open, tubular section, such that the resulting flame manifestly cannot be annular; and,
- there is no teaching, suggestion or motivation in the art to modify Choy *et al.* and Hitachi to arrive at the recitations of claims 29-44.

E) Claim 51 Is Patentable Over Choy et al. (WO 97/21848)
in view of Blackwell et al. (U.S. Patent 6,312,656) and further in view of Japan 62-220376)

Whether claim 51 that is clearly patentable over Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (U.S. Patent 6,312,656) and further in view of Japan 62-220376, should be allowed as there is no teaching or suggestion of the claimed methods and apparatus including an annular flame combustion region especially when:

- Choy *et al.* is directed to an apparatus and method which requires an increasing temperature gradient between the outlet (5) and the substrate (14), as disclosed in the summary of the invention at page 1, lines 22 to 30, particularly lines 29 and 30;
- Blackwell *et al.* is directed to a combustion region; and,
- Blackwell *et al.* discloses the delivery of fuel through an annular outlet, this being the outlet defined by the outermost channel (47); the outermost channel (47) being a frusto-conical channel and not a cylindrical channel; wherein the channels (43-47) are concentric (column 9, lines 6 and 7), meaning that the channels (43-47) have a common center; and wherein the outermost channel (47), in being a frusto-conical channel, manifestly cannot provide for the generation of an annular flame combustion region; and,

➤ Japan 62-220376 is directed to an apparatus having a mesh electrode which serves to create a corona discharge between two electrodes, and is wholly different from the mesh of the present claims which removes soot from the flame, and in any event, does not provide any teaching of an annular flame; and,

➤ there is no teaching, suggestion or motivation in the art to modify Choy *et al.* (WO 97/21848) and Blackwell *et al.* (U.S. Patent 6,312,656) and Japan 62-220376 to arrive at the recitations of claim 51.

In short, and as fully discussed below, Applicants answer the foregoing questions in the affirmative, i.e., Appellants respectfully assert that there is NO support for an anticipation or obviousness rejection and that the claims are patentable over Hitachi (JP 56-5337), Hitachi (JP 56-5337) in view of Japan 62-220376, Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (US 6,312,656), Choy *et al.* (WO 97/21848) in view of Hitachi (JP 56-5337), Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (U.S. Patent 6,312,656) and further in view of Japan 62-220376; and, that the rejection of the present application should be reconsidered and withdrawn, and that claims 29-56 should be allowed, with such relief also respectfully requested.

ARGUMENT

THE REJECTION OF ALL CLAIMS UNDER 35 U.S.C. §102 IS OVERCOME

Claims 45-50 and 52-56

There is no prima facie anticipation between the instant claims and Hitachi.

The instant invention is directed to, *inter alia*, methods of depositing material on a substrate, comprising the steps of delivering from a first outlet a stream of droplets of a precursor liquid towards a substrate; applying an electric field between the first outlet and the substrate; and delivering from a second outlet a flow of fuel about the stream of droplets such as to provide an annular flame combustion region between the first outlet and the substrate through which at least a portion of the stream of droplets passes before reaching the substrate, whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, to provide the deposited material. The present invention is also directed to an apparatus for depositing material on a substrate, comprising: a nozzle assembly including a first outlet from which a stream of droplets of a precursor liquid is in use delivered to a substrate, and a second outlet from which a flow of fuel is in use delivered such as to provide an annular flame

combustion region through which at least a portion of the stream of droplets in use passes before reaching the substrate; a precursor supply for supplying a precursor liquid to the nozzle assembly; an electrical supply for applying an electric field between the first outlet and the substrate; and a burner for generating the flame of the annular flame combustion region between the first outlet and the substrate; whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, in the annular flame combustion region to provide the deposited material.

For a Section 102 rejection to be proper, the single prior art reference must contain all of the elements of the claimed invention, *see Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987), and, the single prior art reference must contain an enabling disclosure, *see Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990).

It is respectfully submitted that Hitachi does not anticipate the present invention as Hitachi does not teach methods of depositing material on a substrate, comprising the steps of delivering from a first outlet a stream of droplets of a precursor liquid towards a substrate; applying an electric field between the first outlet and the substrate; and delivering from a second outlet a flow of fuel about the stream of droplets such as to provide an annular flame combustion region between the first outlet and the substrate through which at least a portion of the stream of droplets passes before reaching the substrate, whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, to provide the deposited material.

Both the April 13, 2005 Office Action and the December 27, 2005 Office Action state that “Hitachi’s apparatus was identical in structure to the claimed apparatus as it included a first central outlet 11’, a second outlet 9’, a third outlet 7’ a precursor supply 1, an electrical supply 21, an annular electrode 23, a positioner 13, and a burner (9’, 11’ and 7’ form a burner face).” It is submitted that this is an incorrect assertion. To the contrary, and as argued in the response filed October 13, 2005, the apparatus of Hitachi cannot result in an annular flame, thereby rendering the present claims patentable over Hitachi. As admitted by the office action, the burner face comprises 9’, 11’ and 7’. As Applicants previously argued, Hitachi demonstrates a gas entraining a spray of a liquid (1) is ignited and combusted at the mouth of the nozzle (11’) through which the gas is delivered. As the nozzle (11’) is an open, tubular section, the resulting flame manifestly cannot be annular as now required by the claimed invention. Furthermore, both the April 13, 2005 Office Action and the December 27, 2005 Office Action’s characterization of

the burner face supports Applicant's contention that the resulting flame is not annular as a burner face necessarily implies a flame across the entire face - in this instance, across 9', 11', and 7' - such that the flame cannot be annular.

In response to the argument set forth by the Applicant in the October 13, 2005 Response, the Examiner stated that Applicant's arguments based on drawings are not well taken. Applicants submit that the burden was on the Examiner to set point to some part of Hitachi which concretely described an annular flame, which the Examiner failed to do.

As the pending claims require the presence of an annular flame and the Examiner has failed to specifically indicate where Hitachi teaches an annular flame, the applicant maintains that Hitachi does not disclose the generation of an annular flame combustion region as alleged by the Examiner.

**THE REJECTION OF ALL CLAIMS
UNDER 35 U.S.C. §103 IS OVERCOME**

The instant invention is directed to, *inter alia*, methods of depositing material on a substrate, comprising the steps of delivering from a first outlet a stream of droplets of a precursor liquid towards a substrate; applying an electric field between the first outlet and the substrate; and delivering from a second outlet a flow of fuel about the stream of droplets such as to provide an annular flame combustion region between the first outlet and the substrate through which at least a portion of the stream of droplets passes before reaching the substrate, whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, to provide the deposited material. The present invention is also directed to apparatus for depositing material on a substrate, comprising: a nozzle assembly including a first outlet from which a stream of droplets of a precursor liquid is in use delivered to a substrate, and a second outlet from which a flow of fuel is in use delivered such as to provide an annular flame combustion region through which at least a portion of the stream of droplets in use passes before reaching the substrate; a precursor supply for supplying a precursor liquid to the nozzle assembly; an electrical supply for applying an electric field between the first outlet and the substrate; and a burner for generating the flame of the annular flame combustion region between the first outlet and the substrate; whereby the precursor liquid is chemically reacted, or decomposed, or

chemically reacted and decomposed, in the annular flame combustion region to provide the deposited material.

In order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

A. Claim 51

There is no prima facie obviousness between the instant claim and Hitachi in combination with JP 62-220376.

It is respectfully submitted that Hitachi in combination with JP 62-220376 does not render obvious the apparatus of the present invention, having a nozzle assembly including a first outlet from which a stream of droplets of a precursor liquid is in use delivered to a substrate, and a second outlet from which a flow of fuel is in use delivered such as to provide an annular flame combustion region through which at least a portion of the stream of droplets in use passes before reaching the substrate; a mesh disposed between the first outlet and the substrate; a precursor supply for supplying a precursor liquid to the nozzle assembly; an electrical supply for applying an electric field between the first outlet and the substrate; and a burner for generating the flame of the annular flame combustion region between the first outlet and the substrate; whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, in the annular flame combustion region to provide the deposited material.

Both the April 13, 2005 Office Action and the December 27, 2005 Office Action alleged that claim 51 was obvious over Hitachi in view of Japan as Hitachi taught an apparatus having a first central outlet 11', a second outlet 9', a third outlet 7' a precursor supply 1, an electrical

supply 21, an annular electrode 23, a positioner 13, and a burner (9', 11' and 7' form a burner face) and that Japan 62-220376 taught the presence of a wire-mesh electrode. Applicants disagree with this assertion.

To the contrary, and as argued in the response filed October 13, 2005, the apparatus of Hitachi cannot result in an annular flame, thereby rendering the present claims patentable over Hitachi. As admitted by the office action, the burner face comprises 9', 11' and 7'. As Applicants previously argued, Hitachi demonstrates a gas entraining a spray of a liquid (1) is ignited and combusted at the mouth of the nozzle (11') through which the gas is delivered. As the nozzle (11') is an open, tubular section, the resulting flame manifestly cannot be annular as now required by the claimed invention. Furthermore, both the April 13, 2005 Office Action and the December 27, 2005 Office Action's characterization of the burner face supports Applicant's contention that the resulting flame is not annular as a burner face necessarily implies a flame across the entire face - in this instance, across 9', 11', and 7' - such that the flame cannot be annular.

Furthermore, as additionally argued in the October 13, 2005 Response, the mesh electrode of JP 62-220376 serves to create a corona discharge between two electrodes. This is in contrast to the present invention, which already contains an electric field which is generated from high voltage source 45, and exists between the nozzle assembly 10 and substrate 50. Rather than acting as the source of the electric field in the present invention, and indeed, the mesh of the present invention is not related to the presence of the electric field in any sense, the mesh instead serves to assist in removing soot from the flame. The Examiner indicates that it would have been obvious to use a wire-mesh electrode like that of JP 66-220376 with the arrangement of Hitachi "because a mesh would have been equivalent to the electrode of Hitachi." This assertion has no basis, however, as there is no motivation for one of skill in the art to add a mesh electrode to an apparatus which already contains means for generating an electric field.

In summary, it is submitted that a person skilled in the art would not have contemplated modifying the apparatus or method of Hitachi in accordance with the teaching of JP 62-220376 to use a wire mesh electrode, and furthermore such a combination fails to teach an annular flame, and, notwithstanding any such modification of Hitachi, the claimed invention is clearly distinguished over the disclosures of Hitachi and JP 62-220376 when taken in combination.

B. Claims 29-50 and 52-56

There is no prima facie obviousness between the instant claims and Choy et al. in combination with Blackwell et al.

It is respectfully submitted that the combination of Choy *et al.* and Blackwell *et al.* do not render the present invention obvious, i.e. Choy *et al.* and Blackwell *et al.* do not combine to provide methods of depositing material on a substrate, comprising the steps of delivering from a first outlet a stream of droplets of a precursor liquid towards a substrate; applying an electric field between the first outlet and the substrate; and delivering from a second outlet a flow of fuel about the stream of droplets such as to provide an annular flame combustion region between the first outlet and the substrate through which at least a portion of the stream of droplets passes before reaching the substrate, whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, to provide the deposited material. Nor does such a combination provide an apparatus for depositing material on a substrate, comprising: a nozzle assembly including a first outlet from which a stream of droplets of a precursor liquid is in use delivered to a substrate, and a second outlet from which a flow of fuel is in use delivered such as to provide an annular flame combustion region through which at least a portion of the stream of droplets in use passes before reaching the substrate; a precursor supply for supplying a precursor liquid to the nozzle assembly; an electrical supply for applying an electric field between the first outlet and the substrate; and a burner for generating the flame of the annular flame combustion region between the first outlet and the substrate; whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, in the annular flame combustion region to provide the deposited material. Specifically, the rejection relies on Blackwell *et al.* as disclosing the generation of an annular flame combustion region. Applicants respectfully assert that this is not a correct reading of Blackwell *et al.*

Each of the March 5, 2002, November 12, 2002, June 9, 2003, June 11, 2004, April 13, 2005 and December 27, 2005 Office Actions have stated that Choy *et al.* does not show, “generating a flame from a burner coaxial with the droplet outlet,” and that Blackwell *et al.* shows, “combustion processes and apparatus for atomized liquid reactants wherein atomization can be done electrostatically.” December 27, 2005 Office Action at 5. Additionally, the Office Actions continued that while Choy *et al.* “does not show the claimed sequence of annular gas

jets,” Blackwell *et al.* shows the “use of inert shield gas between liquid precursor droplets and an outer, annular fuel gas jet.” December 27, 2005 Office Action at 5.

The Examiner was apparently alleging that fuel is delivered through an annular channel, namely, the outermost channel (47), and, as such, the flame combustion region (23) must necessarily be annular. It is submitted that this allegation has no basis.

While the Office Actions were correct in stating that Blackwell *et al.* shows combustion processes, it was respectfully submitted that these combustion processes do not include the annular fuel gas jet alleged in the Office Actions.

Rather, Blackwell *et al.* demonstrates the use of a single or multi-jet fuel source which gives rise to a single, continuous flame area. The Examiner was respectfully invited to review figures 2-4 of Blackwell *et al.*, especially figure 4, which demonstrates that the burner (40) includes a number of concentric channels, but that the concentric channels provide a single, continuous flame area, not an annular flame combustion region as stated in the claims of the present invention.

In response to Appellant’s comments, the November 12, 2002 Office Action alleged that the disclosure of Figure 4 incorrectly represents the flame combustion region (23) and that the shape of the flame in Figure 4 could not be relied upon. Specifically, the Office Action alleged that fuel is delivered through an annular channel, namely, the outermost channel (47), and, as such, the flame combustion region (23) must necessarily be annular. It is respectfully submitted that this allegation has no basis.

As Appellants stated in the May 12, 2003 Response (which was accompanied by a Request for Continued Examination) Appellants acknowledge that Blackwell *et al.* discloses the delivery of fuel through an annular outlet, this being the outlet defined by the outermost channel (47), but the outermost channel (47) is a frusto-conical channel and not a cylindrical channel. Blackwell *et al.* makes no disclosure of the channels (43-47) being cylindrical channels as alleged by the Office Action, but rather that the channels (43-47) are concentric (column 9, lines 6 and 7). Concentricity merely defines that the channels (43-47) have a common center. The outermost channel (47), in being a frusto-conical channel, manifestly cannot provide for the generation of an annular flame combustion region as alleged in the Office Action.

In this regard, it is submitted that the teaching of Figure 4 is quite clear, in disclosing the generation of a single, continuous flame combustion region (23) from a frusto-conical channel

(47). There is nothing in the teaching of Blackwell *et al.* to suggest that Figure 4 incorrectly represents the flame combustion region (23). On the contrary, the inwardly-directed frusto-conical channel (47) as embodied can only provide a single, continuous flame combustion region (23), and, as such, the representation of Figure 4 is submitted to be accurate. Indeed, given that the purpose of the flame combustion region (23) is to provide a conversion site for converting the precursor material into soot particles at the burner face (53) (column 9, lines 13 to 16), it is submitted that the provision of other than a single, continuous flame combustion region (23) would not achieve this purpose. The Examiner is manifestly impermissibly performing a hindsight analysis of the prior art in attempting selectively to disregard the teaching of Figure 4 of Blackwell *et al.*

In support of this allegation, the Office Action is relying on the disclosure at column 9, lines 17 to 20, which discloses that “An inert gas, ... is delivered through channel 44 to inhibit reaction of liquid feedstock and soot build-up on burner face 53.” The Office Action considers this disclosure to support his allegation that the flame combustion region (23) is away from the burner face (53), and apparently in an annular region defined by the outermost channel (47).

It is, however, submitted that this teaching referenced in the Office Action in fact contrarily demonstrates that the flame combustion region (23) extends across the burner face (53), particularly the central region thereof which includes the atomizer (41) from which feedstock is delivered. The purpose of delivering an inert gas through an inner channel, namely, inner channel (44), is expressly recited as being to “inhibit reaction of the liquid feedstock and soot build-up on burner face (53).” It is submitted that such inhibition at the burner face (53) is required for the very reason that the flame combustion region (23) extends thereover, as, otherwise, inhibition would be unnecessary, and, as such, and contrary to the Office Action’s allegation, this disclosure is not to the development of an annular flame combustion region (23).

The Examiner is further alleging that the applicant has failed to identify any teaching in Blackwell *et al.*, other than the representation of the flame combustion region (23) in Figure 4, that the flame combustion region (23) is a single, continuous region.

Notwithstanding that the identification of any further teaching should not be required, given the clear disclosure of Figure 4, the applicant has already identified further clear teaching in Blackwell *et al.* to the flame combustion region (23) being a single, continuous region.

As set out hereinabove, the outermost channel (47) is an inwardly-directed frusto-conical channel, and such an inwardly-directed frusto-conical channel (47) as embodied can only provide a single, continuous flame combustion region (23). The generation of a single, continuous flame combustion region (23) results from the outermost channel (47) being a frusto-conical channel.

Indeed, Blackwell *et al.* further discloses (column 8, line 67 to column 9, line 3) that the atomizer (41) “injects very finely atomized liquid reactant particles into flame 23.” For such injection to occur into the flame combustion region (23), the flame combustion region (23) has to extend over the atomizer (41), and, as such, the flame combustion region (23) cannot be annular as alleged by the Office Action.

Furthermore, Blackwell *et al.* discloses (column 9, lines 13 to 17) that “The area proximate to the burner face 53 and flame 23 thus acts as a conversion site for converting liquid projections 42 into soot reactant particles.” As the liquid projections (42) are created at the outlet of the atomizer (41), and the flame combustion region (23) is required to act as the conversion site for converting the liquid projections (42) into soot reactant particles, and the conversion site is required to be proximate the burner face (53), the flame combustion region (23) manifestly has to extend over the atomizer (41), and, as such, cannot be annular as alleged in the Office Action. If the flame combustion region (23) were annular as alleged in the Office Action, the stated conversion of the liquid projections (42) would manifestly not occur proximate the burner face (53).

The June 9, 2003 Office Action maintained the previous rejection, and again reiterated the opinion that Blackwell *et al.* teaches an annular flame region.

Appellants presented arguments in the December 9, 2003 Response again stating that Blackwell *et al.* does not describe an annular flame combustion region, as discussed herein above.

Again, Applicants acknowledge that Blackwell *et al.* describes the delivery of fuel through an annular outlet, this being the outlet defined by the outermost channel (47), but the outermost channel (47) is a frusto-conical channel and not a cylindrical channel. Blackwell *et al.* makes no disclosure of the channels (43-47) being cylindrical channels as alleged by the Examiner, but rather the channels (43-47) are concentric (column 9, lines 6 and 7). Concentricity merely defines that the channels (43-47) have a common center, and is not

necessarily indicative of an annular flame combustion region. Furthermore, and perhaps most importantly, the outermost channel (47), in being a frusto-conical channel, manifestly cannot provide for the generation of an annular flame combustion region as alleged by the Examiner.

Furthermore, the Examiner again alleged that the disclosure of Figure 4 of Blackwell *et al.* incorrectly represents the flame combustion region (23), and cannot be relied upon. Appellants respectfully disagree, and maintain that Figure 4 is not ambiguous; the flame depicted in Figure 4 is clearly drawn as a continuous flame.

In this regard, it is submitted that the teaching of Figure 4 is quite clear, in disclosing the generation of a single, continuous flame combustion region (23) from a frusto-conical channel (47). There is nothing in the teaching of Blackwell *et al.* to suggest that Figure 4 incorrectly represents the flame combustion region (23). On the contrary, the inwardly-directed frusto-conical channel (47) as embodied can only provide a single, continuous flame combustion region (23), and, as such, the representation of Figure 4 is submitted to be accurate. Indeed, given that the purpose of the flame combustion region (23) is to provide a conversion site for converting the precursor material into soot particles at the burner face (53) (column 9, lines 13 to 16), it is submitted that the provision of other than a single, continuous flame combustion region (23) would not achieve this purpose. The Examiner is manifestly impermissibly performing a hindsight analysis of the prior art in attempting selectively to disregard the teaching of Figure 4 of Blackwell *et al.*

Again, disregarding the arguments previously filed by Appellants, the Examiner further alleged that no teaching in Blackwell *et al.*, other than the representation of the flame combustion region (23) in Figure 4, had been pointed to by Appellants in demonstrating that the flame combustion region (23) of Blackwell *et al.* is a single, continuous region.

Notwithstanding that the identification of any further teaching should not be required, given the clear disclosure of Figure 4, the applicant has already identified further clear teaching in Blackwell *et al.* to the flame combustion region (23) being a single, continuous region.

Firstly, as set out hereinabove, the outermost channel (47) is an inwardly-directed frusto-conical channel, and such an inwardly-directed frusto-conical channel (47) as embodied can only provide a single, continuous flame combustion region (23). The generation of a single, continuous flame combustion region (23) results from the outermost channel (47) being a frusto-conical channel.

Secondly, Blackwell *et al.* further discloses (column 8, line 67 to column 9, line 3) that the atomizer (41) “injects very finely atomized liquid reactant particles **into** flame 23” (emphasis added). For such injection to occur into the flame combustion region (23), the flame combustion region (23) has manifestly to extend over the atomizer (41), and, as such, cannot be annular as alleged by the Examiner.

Thirdly, Blackwell *et al.* discloses (column 9, lines 13 to 17) that “The area proximate to the burner face 53 and flame 23 thus acts as a conversion site for converting liquid projections 42 into soot reactant particles.”. As the liquid projections (42) are created at the outlet of the atomizer (41), and the flame combustion region (23) is required to act as the conversion site for converting the liquid projections (42) into soot reactant particles, and the conversion site is required to be proximate the burner face (53), the flame combustion region (23) manifestly has to extend over the atomizer (41), and, as such, cannot be annular as alleged by the Examiner. If the flame combustion region (23) were annular as alleged by the Examiner, the stated conversion of the liquid projections (42) would manifestly not occur proximate to the burner face (53).

Fourthly, the disclosure at column 9, lines 17 to 20, which discloses that “An inert gas, ... is delivered through channel 44 to inhibit reaction of the liquid feedstock and soot build-up on burner face 53”, demonstrates that the flame combustion region (23) extends across the burner face (53), particularly the central region thereof which includes the atomizer (41) from which feedstock is delivered. The purpose of delivering an inert gas through an inner channel, namely, inner channel (44), is expressly recited as being to “inhibit reaction of the liquid feedstock and soot build-up on burner face 53.” It is submitted that such inhibition at the burner face (53) is required for the very reason that the flame combustion region (23) extends thereover, as, otherwise, inhibition would be unnecessary.

Furthermore, the Examiner still alleges that a person skilled in the art would have been motivated to modify the apparatus and method of Choy *et al.* in accordance with the teaching of Blackwell *et al.* to utilize a combustion flame as the heating means for converting the precursor material.

Similar allegations have been maintained by the Examiner in the June 11, 2004 Office Action and the April 13, 2005 Office Action (which referred to the comments in the June 11, 2004 Office Action) wherein the Examiner alleged that the teaching of an annular flame was inherent with Blackwell *et al.* Applicants have maintained that such a teaching is not provided

by Blackwell *et al.*, inherently or otherwise, as the Blackwell *et al.* itself, and specifically Figure 4 has demonstrated otherwise.

Appellants maintain that a person skilled in the art would manifestly not have been so motivated to read Blackwell *et al.* as inherently teaching an annular flame, and at no time has the applicant acquiesced to the Examiner's allegation in this regard.

Choy *et al.* is directed to an apparatus and method which requires an increasing temperature gradient between the outlet (5) and the substrate (14), as disclosed in the summary of the invention at page 1, lines 22 to 30, particularly lines 29 and 30. It is important to recognize that Choy *et al.* does not merely require that an increased temperature be maintained between the outlet (5) and the substrate (14), but rather that an increasing temperature gradient be provided, and more specifically that the increasing temperature gradient be such that the precursor material undergoes de-composition and/or chemical reaction on or in very close proximity to the surface of the substrate (14), as summarized at page 8, lines 22 to 31. The provision of such a heating regime represents the main thrust of the teaching of Choy *et al.*, and, indeed, is disclosed at, for example, page 7, lines 22 and 23 as being the principle of the deposition technique of Choy *et al.*

Given that the teaching of Choy *et al.* is to a deposition technique which essentially requires such a heating regime, it is submitted that a person skilled in the art would have had no possible motivation to contemplate modifying the apparatus or method of Choy *et al.* in a manner which would have been contrary to the very teaching thereof, that is, to provide a heating regime which did not provide an increasing temperature gradient from the outlet (5) to the substrate (14), but contrarily provided for conversion of the precursor material at the outlet (5) and away from the substrate (14).

This notwithstanding, the applicant maintains that Blackwell *et al.* does not disclose the generation of an annular flame combustion region as alleged by the Examiner.

In summary, it is submitted that a person skilled in the art would not have contemplated modifying the apparatus or method of Choy *et al.* in accordance with the teaching of Blackwell *et al.* to utilize a combustion flame, and, notwithstanding any such modification of Choy *et al.*, the claimed invention is clearly distinguished over the disclosures of Choy *et al.* and Blackwell *et al.* when taken in combination.

C. Claims 29-44

There is no prima facie obviousness between the instant claims and Choy et al. in combination with Hitachi.

It is respectfully submitted that Choy *et al.* in combination with Hitachi does not render obvious the present invention of methods of depositing material on a substrate, comprising the steps of delivering from a first outlet a stream of droplets of a precursor liquid towards a substrate; applying an electric field between the first outlet and the substrate; and delivering from a second outlet a flow of fuel about the stream of droplets such as to provide an annular flame combustion region between the first outlet and the substrate through which at least a portion of the stream of droplets passes before reaching the substrate, whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, to provide the deposited material.

The April 13, 2005 and December 27, 2005 Office Actions indicated that "Choy *et al.* did not teach an annular flame" and that "As clearly indicated in Figure 1 of Hitachi, the flame '16 is annular". Applicants agree that Choy *et al.* does not teach an annular flame, however, Applicants disagree with the assertion that Hitachi teaches an annular flame, and have never waived from this position.

Both the April 13, 2005 Office Action and the December 27, 2005 Office Action state that "Hitachi's apparatus was identical in structure to the claimed apparatus as it included a first central outlet 11', a second outlet 9', a third outlet 7' a precursor supply 1, an electrical supply 21, an annular electrode 23, a positioner 13, and a burner (9', 11' and 7' form a burner face)." It is submitted that this is an incorrect assertion. To the contrary, and as argued in the response filed October 13, 2005, the apparatus of Hitachi cannot result in an annular flame, thereby rendering the present claims patentable over Hitachi.

As admitted by the office action, the burner face comprises 9', 11' and 7'. As Applicants previously argued, Hitachi demonstrates a gas entraining a spray of a liquid (1) is ignited and combusted at the mouth of the nozzle (11') through which the gas is delivered. As the nozzle (11') is an open, tubular section, the resulting flame manifestly cannot be annular as now required by the claimed invention. Furthermore, both the April 13, 2005 Office Action and the December 27, 2005 Office Action's characterization of the burner face supports Applicant's contention that the resulting flame is not annular as a burner face necessarily implies a flame

across the entire face - in this instance, across 9', 11', and 7' - such that the flame cannot be annular.

As the pending claims require the presence of an annular flame and the Examiner has failed to specifically indicate where Hitachi teaches an annular flame, the applicant maintains that Hitachi does not disclose the generation of an annular flame combustion region as alleged by the Examiner, and therefore does not correct the defects of Choy *et al.*

D. Claim 51

There is no prima facie obviousness between the instant claim and Choy et al. and Blackwell et al. in combination with JP 62-220376.

It is respectfully submitted that Choy *et al.* and Blackwell *et al.* in combination with JP 62-220376 does not render obvious the present invention of an apparatus for depositing material on a substrate, comprising: a nozzle assembly including a first outlet from which a stream of droplets of a precursor liquid is in use delivered to a substrate, and a second outlet from which a flow of fuel is in use delivered such as to provide an annular flame combustion region through which at least a portion of the stream of droplets in use passes before reaching the substrate; a precursor supply for supplying a precursor liquid to the nozzle assembly; an electrical supply for applying an electric field between the first outlet and the substrate; and a burner for generating the flame of the annular flame combustion region between the first outlet and the substrate; whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, in the annular flame combustion region to provide the deposited material.

All of the June 11, 2004, April 13, 2005 and December 27, 2005 Office Actions stated that it would have been obvious to use a wire-mesh electrode like that of JP 62-220376 in the arrangement of Choy *et al.* and Blackwell *et al.*, because a mesh would have been equivalent to the ring electrode of Choy *et al.* Applicants have disagreed with this assertion in previous responses and continue to do so.

As argued in the October 13, 2005 Response, the mesh electrode of JP 62-220376 serves to create a corona discharge between two electrodes. This is in contrast to the present invention, which already contains an electric field which is generated from high voltage source 45, and exists between the nozzle assembly 10 and substrate 50. Rather than acting as the source of the electric field in the present invention, and indeed, the mesh of the present invention is not related

to the presence of the electric field in any sense, the mesh instead serves to assist in removing soot from the flame.

Therefore, as the mesh in the present invention has a different function than that of the mesh in JP 62-220376, the Examiner's assertion that it would have been obvious to combine the mesh of JP 62-220376 with the arrangement Choy *et al.* and Blackwell *et al.* has no basis as there is no motivation for one of skill in the art to add a mesh electrode to an apparatus which already contains means for generating an electric field.

Furthermore, as discussed in previous responses and above, Applicants maintain that the combination of Choy *et al.* and Blackwell *et al.* fail to teach an apparatus which generates an annular flame, and the combination of these documents with JP 62-220376 does nothing to remedy this deficiency.

In summary, it is submitted that a person skilled in the art would not have contemplated modifying the already deficient apparatus or method formed by combination of Choy *et al.* and Blackwell *et al.* in accordance with the teaching of JP 62-220376 to use a wire mesh electrode, and furthermore such a combination fails to teach an annular flame, and, notwithstanding any such modification of Choy *et al.* and Blackwell *et al.*, the claimed invention is clearly distinguished over the disclosures of Choy *et al.*, Blackwell *et al.* and JP 62-220376 when taken in combination.

CONCLUSION

For the reasons discussed in this brief and the arguments of record (incorporated herein by reference), claims 45-50 and 52-56 are patentable over Hitachi (JP 56-5337), claim 51 is patentable over Hitachi in view of Japan 62-220376, claims 29-56 are patentable over Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (US 6,312,656), claims 29-44 are patentable over Choy *et al.* (WO 97/21848) in view of Hitachi (JP 56-5337), and claim 51 is patentable over Choy *et al.* (WO 97/21848) in view of Blackwell *et al.* (U.S. Patent 6,312,656) and further in view of Japan 62-220376. It is, therefore, respectfully submitted that the Examiner erred in rejecting claims 29-56, and a reversal of the rejection of claims 29-56 by this Honorable Board, and prompt issuance of a Notice of Allowance, are earnestly solicited.

Respectfully submitted,
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CLAIMS APPENDIX

Currently Pending Claims:

29. A method of depositing material on a substrate, comprising the steps of:
delivering from a first outlet a stream of droplets of a precursor liquid towards a substrate;
applying an electric field between the first outlet and the substrate; and
delivering from a second outlet a flow of fuel about the stream of droplets such as to provide an annular flame combustion region between the first outlet and the substrate through which at least a portion of the stream of droplets passes before reaching the substrate, whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, to provide the deposited material.
30. The method according to claim 29, wherein the chemical reaction, or the decomposition, or the chemical reaction and decomposition, occurs in a higher temperature overlap zone between the stream of droplets and the annular flame combustion region.
31. The method according to claim 29, wherein the flow of fuel is a diverging flow.
32. The method according to claim 29, wherein the first and second outlets are coaxial.
33. The method according to claim 29, wherein the stream of droplets is provided as a diverging spray.
34. The method according to claim 29, further comprising the step of:
delivering a flow of cold gas in a direction from the first outlet towards the substrate.
35. The method according to claim 34, wherein the flow of cold gas is delivered from a third outlet as a flow about the stream of droplets and within the flow of fuel.

36. The method according to claim 35, wherein the first and third outlets are coaxial.
37. The method according to claim 29, wherein the material is a ceramic material.
38. The method according to claim 29, wherein the material is a multicomponent oxide material.
39. The method according to claim 29, further comprising the step of:
heating the substrate.
40. The method according to claim 29, wherein the precursor liquid is a sol precursor solution.
41. The method according to claim 29, further comprising the step of:
moving one or both of the substrate and the first outlet during deposition so as to deposit a three-dimensional structure as a series of overlying layers.
42. The method according to claim 29, further comprising the step of:
controlling a region of deposition by varying one or more of a rate of flow of the fuel, a separation between the first outlet and the substrate and the electric field between the first outlet and the substrate.
43. The method according to claim 29, wherein the material is deposited as a powder and the chemical reaction, or the decomposition, or the chemical reaction and decomposition, occurs away from the substrate.
44. The method according to claim 29, wherein the material is deposited as a solid film and the chemical reaction, or the decomposition, or the chemical reaction and decomposition, occurs in the vicinity of the substrate.

45. An apparatus for depositing material on a substrate, comprising:
a nozzle assembly including a first outlet from which a stream of droplets of a precursor liquid is in use delivered to a substrate, and a second outlet from which a flow of fuel is in use delivered such as to provide an annular flame combustion region through which at least a portion of the stream of droplets in use passes before reaching the substrate;
a precursor supply for supplying a precursor liquid to the nozzle assembly;
an electrical supply for applying an electric field between the first outlet and the substrate; and
a burner for generating the flame of the annular flame combustion region between the first outlet and the substrate;
whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, in the annular flame combustion region to provide the deposited material.
46. The apparatus according to claim 45, wherein the chemical reaction, or the decomposition, or the chemical reaction and decomposition, occurs in a higher temperature overlap zone between the stream of droplets and the annular flame combustion region.
47. The apparatus according to claim 45, wherein the first and second outlets are coaxial.
48. The apparatus according to claim 45, wherein the nozzle assembly further comprises a third outlet disposed between the first and second outlets from which a flow of cold gas is in use delivered.
49. The apparatus according to claim 48, wherein the first and third outlets are coaxial.
50. The apparatus according to claim 45, wherein the first outlet is a central outlet.
51. An apparatus for depositing material on a substrate, comprising:

a nozzle assembly including a first outlet from which a stream of droplets of a precursor liquid is in use delivered to a substrate, and a second outlet from which a flow of fuel is in use delivered such as to provide an annular flame combustion region through which at least a portion of the stream of droplets in use passes before reaching the substrate;

a mesh disposed between the first outlet and the substrate;

a precursor supply for supplying a precursor liquid to the nozzle assembly;

an electrical supply for applying an electric field between the first outlet and the substrate; and

a burner for generating the flame of the annular flame combustion region between the first outlet and the substrate;

whereby the precursor liquid is chemically reacted, or decomposed, or chemically reacted and decomposed, in the annular flame combustion region to provide the deposited material.

52. The apparatus according to claim 45, further comprising:
an electrode at an electric potential between the potential of the first outlet and the substrate and disposed between the first outlet and the substrate.

53. The apparatus according to claim 52, wherein the electrode is an annular electrode.

54. The apparatus according to claim 45, further comprising:
a positioner for altering the relative position of the first outlet and the substrate.

55. The apparatus according to claim 45, where configured such that the chemical reaction, or the decomposition, or the chemical reaction and decomposition, occurs away from the substrate so as to provide the material as a powder.

56. The apparatus according to claim 45, where configured such that the chemical reaction, or the decomposition, or the chemical reaction and decomposition, occurs in the vicinity of the substrate so as to provide the material as a solid film.

EVIDENCE APPENDIX

None.

RELATED PROCEEDING APPENDIX

None.